



Patent Application
Attorney's Docket No.: MET-011DV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jeffery M. Besterman, Jubrail Rahil and Rex Pratt
Application No.: 10/628,649 Group: 1626
Filed: July 28, 2003 Examiner: Shiao, Rei Tsang
Confirmation No.: 4430
For: ACYL PHOSPHONATE INHIBITORS OF BETA-LACTAMASES

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Date: 5/11/06

Signature Melissa Simpson

Printed Name: Melissa Simpson

PETITION TO THE DIRECTOR UNDER 37 C.F.R. §1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Petition to the Director under 37 C.F.R. §1.144 (hereinafter "Petition") is being filed in response to the Office Actions mailed from the U.S. Patent and Trademark Office on August 31, 2005 (hereinafter "the first Office Action"), and January 17, 2006 (hereinafter "the second Office Action"), in the above-identified application.

In response to the first Office Action, Applicants requested reconsideration of the Restriction Requirement and Election of species requirement. According to the second Office

Action, Applicants traversal was not found persuasive. Therefore, Applicants request that the Director review the Restriction Requirement in view of the following reasons.

Applicants traverse the restriction requirement (in part) and the election requirement. Applicants bring to the Director's attention a restriction requirement issued in related US Application Serial No. 09/797,308 (hereinafter the '308 application)(now US 6,599,889). In the '308 application Examiner Solota considered the same 50 claims as pending in the instant application and restricted the claims into 4 groups and did not require Applicants to elect a single species for search purposes. In the '308 application, Applicants selected Group I which included claims directed towards compositions and methods of use of formula I. The Examiner was able to search the claims without the need for a species election and a patent issued for claims directed towards Group I. Because the previous Examiner was able to search the formula I (and was willing to search formula II) without an election of species requirement, there would be no undue burden to search general formula II in the instant application. Applicants respectfully request that the election of species requirement be withdrawn.

Furthermore, because Examiner Solota found that the compositions and methods of the use thereof did not constitute distinct and independent inventions; Applicants respectfully request that Groups III, IV, VI and VIII be combined in the instant application. Groups II and IV in the '308 application overlap with Group III in the instant Restriction Requirement with only the methods of use claims missing from instant Group III. Because the previous Examiner did not find a burden searching the general compositions and their methods of use, Applicants respectfully submit that there is no burden on the instant Examiner to do the same. Therefore, Applicants request that Claims 5-7, 11, 16-18, 22-24, 29-31, 36-37, 42-44 and 48-50 be searched and examined in the instant application.

In the second Office Action, Examiner Shiao states that each of the inventions contains a plurality of patentably distinct compounds far too numerous to list individually. Examiner Shiao goes on to state the a search of a commercial database of the subject matter of each group in addition to a paper search must be performed, which the examiner found to be quite burdensome. However, as noted above, Examiner Solota was able to search the generic structure of formula I

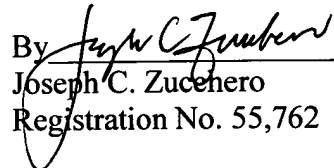
as well as a numerous list specific compounds. Furthermore, a search of the USPTO database would show thousands of patents having an independent claim reciting a broad generic structure followed by various degrees of limiting dependent claims, in which the search of commercial databases of the subject matter of each group in addition to a paper search was carried out by the various examiners.

Applicants request a uniform application of the Restriction Requirement practice so that there can be a reasonable expectation of the course of prosecution, especially between related cases such as continuation and divisional applications. The mere unwillingness of one Examiner to perform the searches readily performed by other Examiners undermines the Restriction Requirement practice and Applicants reasonable expectations. Therefore, Applicants request that the Director combine Groups III, IV, VI and VIII, as listed in the first Office Action; direct that these claims be searched and examined in the instant application; and withdraw the election of species requirement.

Respectfully submitted,

Dated: May 11 2006

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